

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

MEISTER *et al.*

Application No.: 10/715,408

Filed: November 19, 2003

For: **An E-mail System With User Send  
Authorization**

Confirmation No.: 5313

Art Unit: 2453

Examiner: Krisna Lim

Atty. Docket: 3222.1320001

**Statement of Substance of Interview  
In Accordance With 37 C.F.R. § 1.133(b) and M.P.E.P. § 713.04**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

*Mail Stop Amendment*

Sir:

Applicants submit herewith the following Statement of Substance of the Interviews regarding the above captioned application in accordance with 37 C.F.R. § 1.133(b) and M.P.E.P. § 713.04.

The present Statement summarizes the substance of a series of telephone interviews and communications, on or about August 25 - September 1, 2009, between Applicants' attorney and Primary Examiner Lim and Supervisory Examiner Etienne, respectively, regarding the subject application and an Office Action mailed August 19, 2009. Applicants also are in receipt of an Interview Summary (Form PTOL-413) mailed by the U.S. Patent & Trademark Office on September 4, 2009.

In a telephone interview on August 25, 2009, Applicants' attorney requested that Supervisory Examiner Etienne (571-272-4001) review the subject application with respect to the propriety of a new matter objection and corresponding rejection of the pending claims under 35 U.S.C. 112, first paragraph, on the same basis. Applicants' attorney submitted:

(1) the new matter objection in the August 19, 2009 Office Action is improper and/or in error, in that the proposed amendments to the specification in the proposed Amendment After Final Rejection (unentered) and the RCE/Amendment conform, substantially *in haec verba*, to the identified original claims in parent Application No. 09/337,035, which was incorporated

by reference in the present continuation application, and therefor clearly are not new matter;

(2) the rejection of the claims under 35 U.S.C. 112, first paragraph, as allegedly not being supported by the original application (where the Examiner refused to consider the amended portion of the specification), thus likewise is improper and/or in error because the amended claims recite language corresponding to the language of those original claims; and

(3) the new matter objection also appears improper in light of the Examiner's issuance of a "corrected" Advisory Action (mailed July 6, 2009) expressly withdrawing an indication in the original Advisory Action (mailed June 25, 2009) that the proposed Amendment After Final Rejection (unentered) raised issues of new matter, where the issuance of the "corrected" Advisory Action was the result of a telephone call to Examiner Lim by Applicants' attorney inquiring as to that particular issue.

In a telephone interview on August 31, 2009, Supervisory Examiner Etienne (571-272-4001) advised Applicants' attorney that he had reviewed the prosecution of the subject application, and that he had considered the issues and arguments presented in the prior filed Amendment After Final Rejection (unentered), the RCE/Amendment filed July 6, 2009, and the prior telephone conversation of August 25, 2009. Supervisory Examiner Etienne stated:

(1) he agreed the new matter objection in the August 19, 2009 Office Action appears to be improper, in that the proposed amendments to the specification in the proposed Amendment After Final Rejection (unentered) and the RCE/Amendment appear to conform, substantially *in haec verba*, to the identified original claims in parent Application No. 09/337,035, which was incorporated by reference in the present continuation application, and therefor appear not to be new matter;

(2) he agreed the rejection of the claims under 35 U.S.C. 112, first paragraph, as allegedly not being supported by the original application, thus likewise appears to be improper and/or in error;

(3) he agreed that the August 19, 2009 Office Action appears to be improper in light of the Examiner's issuance of a "corrected" Advisory Action particularly withdrawing a prior indication in the original Advisory Action that the proposed Amendment After Final Rejection (unentered) raised issues of new matter.

Supervisory Examiner Etienne stated that he had not yet had an opportunity to discuss this application and the August 19, 2009 Office Action with Primary Examiner Lim because Examiner Lim had been out of the office, but that he would do so immediately and would to

instruct Examiner Lim to withdraw the August 19, 2009 Office Action, including the new matter objection and the corresponding rejection of the claims under 35 U.S.C. 112, first paragraph, in favor of a new, non-final Office Action.

In a telephone interview on September 1, 2009, Primary Examiner Lim (571-272-3956) advised Applicants' attorney that he had discussed the subject application and the August 19, 2009 Office Action with Supervisory Examiner Etienne, and determined to withdraw the August 19, 2009 Office Action, including the new matter objection and the rejection under 35 U.S.C. 112, first paragraph, in favor of a new office action. Examiner Lim stated that the new office action would include an obviousness-type double patenting rejection over claims of parent application no. 09/337,035 (now U.S. Patent No. 6,671,718 issued December 30, 2003), and that a terminal disclaimer over the parent '718 patent would be required to place the application in condition for allowance.

In a follow up telephone communication on September 1, 2009, Examiner Lim advised Applicants' attorney that, after further review of the claims as amended in the RCE/Amendment (including the newly presented claims), he would update his search and examination and issue a new non-final office action.

Respectfully submitted,

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